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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,930	03/22/2006	Robert Linley Muir	17499US01	4948

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McAndrews Held & Malloy
500 West Madison
34th Floor
Chicago, IL 60661

EXAMINER

AHMED, MASUD

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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11/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,930	Applicant(s) MUIR, ROBERT LINLEY	
	Examiner MASUD AHMED	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 54-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 54-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/07/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant has canceled claims 26-53 and 58-63. Examiner has addressed the applicant's argument below.

Response to Arguments

1. Applicant's arguments filed on 07/07/2009 have been fully considered but they are not persuasive. Examiner respectfully disagrees with the applicant at least for the following:
2. In response to the applicant's argument made on examiner's statement of "multiple game screen machines is well known in the art", Examiner disagrees as it was admitted by the applicant on this application page 1 lines 17-20. However examiner has incorporated a new reference as submitted by the applicant to produce a prima facie case of obviousness to the applicant.
3. In response to the applicant's argument on selecting the games based on player's history, examiner again disagrees because as stated and cited on the Schneider reference, whether the games are being customized or altered, game are being selected at the end based on the player's previous history of the game play. For example if player X likes to play Y game with \$1 denomination, however the machine is currently set for \$0.25 denomination, once the machine identifies player X, it sets the denomination to \$1 for player X for the game Y. This selection of the game is based on the player's previous history or habit of playing the game.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-9, 13-25 and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (2003/0078101), in view of Brosnan (WO 01/99067).**

Regarding claims 1, 13, 18 Schneider teaches a network game system having following limitations:

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A gaming system comprising a gaming server, a plurality of gaming machines, and a communications system connecting each of the plurality of gaming machines to the gaming server (para 0016),

the gaming machines each having a display a player interface, and a game controller arranged to control images displayed on the respective display, the gaming system operable to track play of games played by a plurality of players on the gaming machines and the game controller being arranged to play a game initiated by the a player at a said gaming machine (FIG 2 and para 0017),

the game being one of a plurality of games available on the gaming machine and selectable by the player and the game having a game result which, if it is a winning result, will cause the game controller to award a prize to the player, wherein each said gaming machine includes a game selector, which displays a selection of games available on that gaming machine for the player to play (para 0056),

the selection being determined dependent on the player's past history of playing games and a history of games played by other players (para 0038 and 0056). However Schneider is silent on disclosing the game selection is based on the history of games played by others, multiple games screen option on a game machine is well known in the art and as evidenced by the disclosure of Brosnan page 4 lines 28-31. Schneider discloses these games can be selected by the players previous playing history and preferences, it should be noted that Schneider is trying to solve the same problem what applicant's claiming to solve, which is offer players games according to their

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preferences based on previous record and history of the game play, therefore it would have been obvious to ordinary skilled artisan at the time of invention to use other people's game playing history as a determination factor for player selection of the games so they can play popular games and use the method of Brosnan to have multiple game selections so the players can have variety of choices as desired.

Regarding claims 2-3, 14, 19, Schneider discloses the central database records players game playing history of every game played along with other possible interaction with the game playing machines are recorded on the database (para 0027, 0032).

Regarding claims 4-5, 15, 20, As cited and rationale provided by the examiner on claim 1, all the patrons game play history is recorded in a central database and can be identified by patron's identification, therefore as disclosed on para 0027 and 0032, every games played in the machine or in the system are captured or recorded to provide the players are with particular types of games they like to play or simply provide the players with popular games played by others.

Regarding claims 6-7, 21-22, Schneider disclosed the games are tailored or provided upon collecting player's game history data by a recommendation engine in the system (para 0038), further examiner believes a recommendation engine being on the gaming

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machine itself or within the gaming network is an obvious design choice and this feature is not patentably distinct from one another.

Regarding claims 8-9, Schneider discloses recommendation engine connected in a network that collects data from every player playing habits along with others statistical information (para 0038-0042), based on these information players are provided with the customized games or tailored games to suit their needs

4. Claims 10-12, 16-17, 23-25, 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US 2003/0078101), in view of Brosnan, further in view of Paulsen (US 2002/0142846).

Regarding claims 10-12, 16-17, 23-25, As disclosed by Schneider on the above claims that various player's information is captured or recorded to tailor the games accordingly when players are identified, though it can be conclude from Schneider's disclosure that the popular games are recommended based on the players historical data, however examiner believes to establish the obviousness showing to the applicant, applicant is entitled to receive an evidence for the obviousness allegation, therefore examiner draws applicant attention to the Paulsen (para 0011-0017), wherein Paulsen discloses various aspects of the invention including customizing games and providing popular or preferred games to the players based on the previously collected players

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data and selections of the games among various groups of games, therefore it would have been obvious to ordinary skilled artisan at the time of invention to use Schneider's players historical data information to provide players with the popular games that are played by many players as an additional option to the other selectable games.

Regarding claim 54, Schneider discloses plurality of games can be accessed from the various machines (para 0013).

Regarding claims 55-57, Schneider discloses win/loss recording factor as a part of the game history capturing can play a role in customizing or tailoring the game for the preferred users (para 0045), which can be considered as ranking of the player and presenting the game options accordingly, further Schneider discloses certain demographics such as players age as a determination factor (para 0046).

Conclusion

5. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 07/072009 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

6.

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 10:00am-7:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./
Examiner, Art Unit 3714

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714